



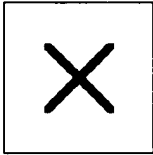
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/863,877

Filing Date: May 23, 2001

Appellant(s): AMANO ET AL.

Brian E. Hennessey

For Appellant

EXAMINER'S ANSWER

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

[Claim Rejections - 35 USC § 112]

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the Appellant regards as his invention.

Claims 4 are rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Claim 4 is said to be ambiguous or confusing for reciting "The advertisement supplying system as claimed in claim 1 wherein: a minimum value of the point degree to be displayed is equal to zero" since parent claim 1 recites that **"the point degree does not decrease to zero"**.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 8, 9 and 10 (including their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The

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claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Here, although fig. 5 appears to show that the display point degree can be equal to zero (0), however, the specification, including the portions mentioned by the Appellant, does not immediately support that **“the display point degree does not decrease to zero for the subsequent display of the advertisement information...”**. To this end, the claims will be given their broadest interpretation in accordance with the specification.

Claims 1, 5, 8, 9 and 10 (including their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. **In fact**, the relationship between the “display point degree”, the “points themselves”, “point-appearing time” and “point-appeared time” is not clear and the portions mentioned by the Appellant do not clarify that either. In general, the specification simply repeats what it is shown in the drawings. Further, it is unclear how the “point degree” is being computed or determined with respect to the points. The relevance of the “display point degree”, as far as the subject matter or patentability is concerned, is not defined so as to enable one of ordinary skills in the art to practice the invention or to at least apply a point degree in combination with a point assignment to a banner ad (metes and bounds problem). Moreover, the Examiner notes that the “point degree” or “display point degree” is not a factor/multiplier or some kind of indexing. In short, the significance or contribution of the “point degree” to the claims is not clearly or

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immediately appreciated. To this end, the claims will be given their broadest interpretation or the “display point degree” is interpreted as “point display”.

[Claim Rejections - 35 USC § 102]

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-10 are rejected under 35 USC 102(b) as being anticipated by Golhaber, US Patent 5, 794, 210.

As per claims 1 and 4-10, Goldhaber discloses a system wherein, in one embodiment, an advertiser 62 creates one or more ads 68 that appeal to certain consumers 64, not to others, in accordance with their interest profile 124 (targeted advertisements). The advertiser 62 provides or forwards the created and targeted ads 68 to the Attention brokerage server 106, for permanent storage and later retrieval (storage apparatus), acting as a broker or intermediary between the consumers or viewers 64 and advertisers 62, which transmits or routes the one or more created ads 68 to appropriate consumers 64, upon logging into the system or server 106, contingent upon their psychographic profile 124 (identification data), stored on the Attention brokerage server 106, matching the advertiser's 62 interest profile or criteria (displaying a targeted ad on the viewer's terminal 104 upon identifying the user or viewer when the viewer logs into the server or

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storage apparatus 106 over the network 102). In short, Attention brokerage servers 106 store information and disseminate it to consumers' computers 104 over a network 102 (Internet) and the servers 106 provide the software agent 110 with targeted or tagged ads, directed to the consumers' or users' attention in accordance with their interest profile 124, to be viewed or reviewed by consumers 64. Moreover, in another embodiment, a software agent 110 related to a user's 64 device or computer 104, working on behalf of the user, screens and filters the incoming ads 68, provided to the Attention brokerage server 106 by advertiser or advertisement owner 62, transmitted by the Attention brokerage server 106 to be displayed to the user 64 based on the user's psychographic information 124 stored on the user's computer 104 local database 120. Subsequent to this screening or filtering process, matches achieving a certain threshold of interest (adjustable by the consumer who owns the profile) represented in the form of "agent reports" consisting of short summaries or thumbnails or pointers are displayed on the user's computer 104, wherein, upon activating a thumbnail view indicative of an ad matching, the user's computer 104 or the software agent 110 retrieves the full text and/or graphics corresponding to the matched advertisement 68. In other words, the software agent 110 maintains the user's psychographic or interest profile 124 confidential and performs the screening, filtering and matching itself based on a correlation between the ad criteria presented by the Attention brokerage server 106, on behalf of the advertiser 62; and the user's interest profile 124 stored on the user's computer 104. When matches are found, as indicated by the software agent 110, the Attention brokerage server 106, which stores in a database the advertiser's ads, delivers the matching ads to the user's computer 104 or the software agent 110

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may itself retrieve the matching ads from the Attention brokerage server 106 database to be displayed on the user's computer 104.

Alternatively, the software agent 110 may retrieve "thumbnail" brief summaries of the matching ads, associated with a plurality of advertisers, and display them along with associated Cybercoin icons on the user's computer 104, wherein upon activating a Cybercoin icon, showing a related dollar figure, displayed next to a "thumbnail" brief summary representing a matching ad, the ad full text and/or graphics is retrieved and displayed to the user and the user is compensated in an amount equal to the value of the displayed Cybercoin (displaying a point degree in combination with an advertisement from an advertisement owner or advertiser).

(Col. 14: 17 to col. 15: 17; col. 15: 48 to col. 16: 5; col. 19: 26-31; col. 19: 36-61; col. 9: 53-61; col. 6: 24-31; col. 7: 8-19; col. 8: 41-48; col. 10: 9-38).

Further, Goldhaber discloses a method of and system for brokering and selling the attention of a customer wherein, among other things, advertisers pay or compensate the customer for the opportunity to have their ads read by the customer or subscriber of the system. By clicking on a Cybercoin button (or banner, ad box or link) or selectable object, displayed on the customer's PC 104 and representative of an ad, the customer indicates his intention to read the said ad and once the system verifies, through a quiz process, that the customer has indeed read or interacted with the ad or advertisement, which guarantees that the advertiser's message has received full human attention or interaction, the customer is compensated in the form of credits or digital cash (points) for paying attention to the ad. **Here, the value of the credits or digital cash (displayed points degree) is equal to the amount shown on the Cybercoin. As time goes by, the customer accumulates a certain amount of credits or digital cash (points balance)**

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for reading a plurality of targeted ads from a plurality of advertisers, wherein the credits balance or digital cash balance (points total) is stored in a database or customer's digital cash repository 126 and the customer's digital cash repository or the customer's account storing the customer's credits is debited for the customer's use or ordering of information unit, medical report, service, goods, movies, etc (redemption of credits or digital cash).

In addition, Goldhaber discloses a system wherein one or more ad titles or thumbnails are displayed on the customer's terminal along with one or more respective selectable objects or Cybercoins showing the associated monetary amount that the customer will earn if he activates a particular selectable object to read the corresponding advertisement (full version of the ad).

(Col. 16: 6-64; fig. 12; col. 7: 48-61; col. 11: 32-38) and (Col. 4: 47-63; Col. 19: 56-67; figs. 10-11).

Furthermore, Goldhaber discloses a system wherein advertisers pay users to view their advertising messages in accordance with the user's profile matching the advertisers' criteria or specifications (advertiser's rule to determine a point degree or monetary value of a displayed Cybercoin related to an ad). For example, if a user provides no profile data to an interesting advertiser, then the point degree or the monetary value shown on a displayed Cybercoin, related to an advertisement from an advertiser, is less significant. On the other hand, if the user makes his profile available to the interesting advertiser, who uses the profile information to tailor his ads to the user, then the displayed point degree or monetary value related to the displayed Cybercoin corresponding to the advertisement from the advertiser is more significant (col. 14: 5-10). In another embodiment, the point degree or the monetary value related to a displayed Cybercoin corresponding to an ad from an advertiser is determined based on the highest bid

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amount offered by an interesting advertiser from a plurality of advertisers for the opportunity to present at least one ad to a targeted user, wherein the bidding process may be silent (passive) or active (advertiser's criteria to determine a point degree...-col. 4: 32-64).

Additionally, Goldhaber discloses a system wherein once a user has successfully activated a displayed Cybercoin and adequately read or interacted with the associated advertisement, then the user's digital cash repository 126 is updated or increased accordingly and **the displayed Cybercoin is deactivated (or its value is now equal or decreased to zero)** to prevent the user from repeatedly clicking on the Cybercoin in the future to read the same advertisement and being compensated for such actions (fig. 12; col. 17: 33-63). It is further recognized that the displayed Cybercoin 62 (selectable object or banner) may be replaced with a coupon icon 63, which performs similar functions (sort or type of point degree or Cybercoin 62 or coupon icon 63 monetary value or amount-col. 18: 13-33).

In short, Goldhaber teaches a system wherein a Cybercoin (display point degree) is displayed on the user's screen along with a targeted ad (in the form of a thumbnail or otherwise-fig. 11) and the user's account or digital cash repository 126 is increased by an amount equal to the value of the displayed Cybercoin or display point degree. Here, when the user clicks on the ad for the first time, the value of the Cybercoin or display point degree is greater than zero (the display point degree does not decrease to zero at this stage). However, in one specific embodiment, it is described that once the user has seen the ad, at least once, the user will not be compensated in the future for reading the same ad. In other words, the value of the Cybercoin or display point degree associated with the same displayed ad decreases to a zero value subsequent to the user reading the ad at least once (Here, at least, Goldhaber hints on the step of displaying the same ad to the

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user more than once and decreasing the value of the point (degree) or Cybercoin to zero for subsequent viewings of the same advertisement once the user has viewed the advertisement in a first period of time and received the displayed compensation or point or Cybercoin).

(10) Response to Argument

[112, second related arguments:]

Contrary to the Appellant's contention, claim 4 is ambiguous or confusing for reciting "The advertisement supplying system as claimed in claim 1 wherein: a minimum value of the point degree to be displayed is equal to zero" since parent claim 1 recites that **"the point degree does not decrease to zero"**. Here, the Appellant submits that claim 1 recites that the point degree does not decrease to **zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement** and claim 1 does not indicate that the point degree never decreases to zero. Arguendo even if the Appellant were correct, dependent claim 4 would still be confusing since the claim would incorrectly suggest that an ad icon or ad title (for argument sake) is first displayed on a user's screen along with a related number of points (e.g. Cybercoin or digital cash), offered to the user as an incentive or enticement to click on the ad icon or banner and read the associated ad, and wherein the value of the related number of points or Cybercoin is equal to zero at a minimum. In other words, no points are offered to the user as an incentive to click on the banner or ad icon and view or read the ad content. This is inconsistent with the spirit of the invention, as featured in at least claim 1, which is to incentivize a user to click for the first time on an ad icon or banner and read or view an associated ad content by displaying a certain number of points or point degree (Cybercoin)

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next to the ad icon or banner. And if such anticipated incentive is zero, then no incentive is being offered to view the ad for the first time, which is inconsistent with the invention. Having said that, dependent claim 4 is said to be ambiguous or confusing, as one of ordinary skills in the art would have concluded. Furthermore, if the minimum number of points (minimum value of the point degree) to be displayed for a first occurrence of an ad is zero, as recited in dependent claim 4, then the system cannot prevent **“the point degree from not decreasing to zero for the subsequent display of the (same) ad or advertisement”** since it is already zero for the first occurrence of the ad or advertisement. That, by itself, renders the claim or claim 4 confusing.

[112, first related arguments:]

Here, although fig. 5 appears to show that the display point degree can be equal to zero (0), however, the specification, including the portions mentioned by the Appellant as shown on page 9 of the current Brief, does not immediately support that **“the display point degree does not decrease to zero for the subsequent display of the advertisement information...”**. For instance, Appellant submits that fig. 12 shows a “diagram explaining an image of a point change rule as to a total gained point number with respect to one banner advertisement”. However, a quick examination of the drawings shows that fig. 13 is actually fig. 12 and fig. 16 is actually fig. 15 and thus, there is a total of 15 figures or drawings in the Application. Further, a quick review of fig. 12 (i.e. fig. 13 in the drawings) does not immediately or remotely reveal that **“the display point degree does not decrease to zero for the subsequent display of the advertisement information...”**. In addition, in “Subsequent, the larger the gained-point number becomes, the smaller the displayed point degree becomes stepwise”, as featured on page 9 of the Brief

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by the Appellant, is not the same as **“the display point degree does not decrease to zero for the subsequent display of the advertisement information...”**. Contrary to the Appellant’s contention, “Gradually decreased” does not necessarily mean that the “the point degree does not decrease to zero” since it is expected that the zero-point degree will eventually be reached in “Gradually decreased”. In short, the argued limitation, **“the display point degree does not decrease to zero for the subsequent display of the advertisement information...”**, is not supported in the specification and that the limitation was introduced simply to overcome the prior art teaching, which discloses that a user will receive no incentive (point-degree) for the subsequent display of the same advertisement after receiving an incentive (a certain number of points) or digital cash for the first display of the advertisement. Moreover, it appears that there is no clear definition for “point-degree” in the specification. Having said that, it is herein being assumed in light of the specification that **“the display point degree will eventually decrease to zero for the subsequent display of the advertisement information...”**.

[Art rejection related arguments:]

Here, the Examiner originally rejected the claims under 35 USC 103(a) by giving patentable weight to **“the display point degree does not decrease to zero for the subsequent display of the advertisement information...”**. However, when the Appellant filed the first Appeal Brief, the Examiner reviewed the claimed invention and then realized that not only **“the display point degree does not decrease to zero for the subsequent display of the advertisement information...”** is not immediately supported in the specification, but also it is at best a non-functional and non-descriptive material. As long as the Examiner gives the Appellant

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an opportunity to respond by making the action, upon re-opening prosecution subsequent to filing an Appeal Brief, non-final, the Examiner's action is deemed proper under the Law.

By re-opening prosecution and giving the Appellant a chance to respond by making the last Office Action Non-Final, all previous actions had become null and void and cannot be incorporated or argued here by reference. The Appellant has to address the last Office Action on the merits, but not the former or previous Action.

What is at stake here is whether or not the Examiner had given the Appellant a fair chance to respond and whether or not the last Office Action was proper under 35 USC 102(b). First, the Examiner had indeed given the Appellant an opportunity to respond by making the last Office Action Non-Final. Second, as far as the argued limitation or "**the display point degree does not decrease to zero for the subsequent display of the advertisement information...**" is concerned, Goldhaber teaches deactivating the Cybercoin (point-degree) for the subsequent display of the same ad to the user or providing no incentive to the user for the subsequent display of the ad after the user has received an incentive (Cybercoin or digital cash or point-degree) for the first time the ad was viewed by the user, which reads on "**the display point degree decreases to zero for the subsequent display of the advertisement information...**" as further supported in the specification. In other words, under 35 USC 102(b), "Deactivation of the Cybercoin for the subsequent display of the same ad", as taught by Goldhaber, literally means that the point display degree for subsequent display(s) of the same ad decreases to or is equal to zero, contrary to the Appellant's contention, since the specification does not support the notion that the point degree does go to zero for subsequent display of the ad. It appears here that the argued and non-supported limitation was specifically and improperly introduced to overcome the

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prior art or the Goldhaber's reference, which does not provide points or Cybercoin for subsequent display of the same ad.

Therefore, the Appellant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Appellant's arguments, as herein presented, are not persuasive and thus, the Examiner's Actions should be sustained..

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

08/18/08

/J. J./

/Jean Janvier/

Primary Examiner, Art Unit 3688

Conferees

Eric Stamber



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